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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/529,587

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JOHN A. DANE

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7590

04/07/2004

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EXAMINER

TODD, GREGORY G

ART UNIT

PAPER NUMBER

2157

DATE MAILED: 04/07/2004

16

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office-Action Summary

Application No.

09/529,587

Applicant(s)

DANE ET AL.

Examiner

Gregory G Todd

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-8, 10-12, 14-20, 23-28 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-8, 10-12, 14-20, 23-28 and 30-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This is a third office action in response to applicant's request for continued examination filed 16 January 2004, of application filed, with the above serial number, on 14 April 2000 in which claims 32-34 have been amended and claims 6, 12, and 26 have been cancelled. Claims 3-5, 7-8, 10-11, 14-20, 23-25, 27-28 and 30-34 are therefore pending in the application.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3-5, 7-8, 10, 14-20, and 23-25, 27-28, and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maniwa (hereinafter "Maniwa", 5,764,866) in view of Franklin et al (hereinafter "Franklin", 6,125,352) and further in view of Westmoreland (hereinafter "DMW", DMW Photo Images).

3. As per Claims 32 and 34, Maniwa discloses a computer method for storing and saving electronic photographic images, wherein Maniwa discloses:

providing access to a server (scan server) having picture memory adapted to store said electronic photographic images, an ordering interface and a communication

link for allowing communication over a public network (digital copier device over LAN)  
(at least col. 5, lines 48-67; Fig. 7);

providing access to said electronic photographic images stored in said picture memory, said ordering interface further providing access to an image profiler adapted to sequence and label (image file - 1...m) (at least Fig. 6) said stored electronic photographic images (scanning/storing at file-server) (at least col. 5, lines 48-56; col. 19, lines 28-43);

wherein said ordering interface is operable to be remotely accessed by said customer of said photographer over said public network using a browser for the purpose of ordering an image product with respect to said stored electronic photographic images (controlling of printer unit) (at least col. 6 line 61 - col. 7 line 5; col. 8, lines 6-16; Fig. ).

Maniwa does not disclose providing access to a server adapted to transact remote payment with respect to a financial institution for verifying payment of an order places through said ordering interface over a public network using a browser. However, the use and advantages for using such a payment method is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Franklin. Franklin discloses a client using a browser and ordering good online wherein the server authorizes and verifies payment of client (at least col. 4, lines 15-61; abstract; Fig. 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Franklin's browser-based payment and verification method into Maniwa's system because this would allow Maniwa's system to be used over a WAN such as the internet and the file and print server to be used in

conjunction with selling consumer electronic photos as this would expand and enhance Maniwa's system to reach more consumers and provide a faster, easier payment method.

Maniwa does not explicitly disclose said electronic photographic images obtained by a photographer at a customer event. However, the use and advantages for using such a photo arrangement is very well known to one skilled in the art at the time the invention was made as evidenced by the teachings of DMW (at least pp. 1, 4). DMW discloses arranging photos according to Rock, alternative, etc. Further, it is very well known that images are most commonly taken by a user with a camera, aka photographer, to capture a particular moment in time, such as an event, and that this limitation is irrelevant as to the novelty of the invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the use of DMW's genre photo arrangement into Maniwa's storing files in a directory service as this would enhance Maniwa's system by allowing the image files to be stored in the directory by an easy to remember method such as a meeting or date, etc.

4. As per Claims 3 and 23.

wherein said ordering interface access providing step further comprises providing access to a customer order selector adapted to enumerate and quantify a subset of said electronic photographic images to be produced as said hardcopy renditions (sending file request command for printout) (at least col. 20, lines 5-15).

5. As per Claims 4 and 24.

wherein said ordering interface access providing step further comprises providing access to a customer proofbook adapted to store a subset of said electronic photographic images, wherein said customer proofbook persists between said remote accesses by said customer (directory service for user image list) (at least col. 21, lines 52-62).

6. As per Claims 5 and 25.

Maniwa does not disclose wherein said payment verifier access providing step enables transmitting payment corresponding to production of said hardcopy renditions in response to notification from said financial institution. However, the use and advantages for using such a payment confirmation is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Franklin (at least col. 27 line 41 - col. 28 line 21). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Franklin's payment and verification method into Maniwa's system because this would allow Maniwa's system to only continue with the printing process if the user is authorized to print, as this would further reduce unwanted workload on Maniwa's host machine (Maniwa col. 4, lines 25-30).

7. As per Claims 7 and 27.

wherein said image loader access providing step enables receiving said electronic photographic images from a non-volatile digital media (hard drive) (at least col. 7, lines 29-30).

8. As per Claims 8 and 28.

wherein said non-volatile digital media is selected from the group consisting of magnetic and optical formats (hard drive) (at least col. 7, lines 29-30).

9. As per Claim 14.

wherein said displaying is in response to interactive selecting by said customer through said publicly accessible network (user selecting image file) (at least col. 21, lines 52-62).

10. As per Claim 15.

Maniwa does not explicitly disclose arranging said electronic photographic images according to an event and said displaying said electronic photographic images occurs selectively according to said event. However, the use and advantages for using such a photo arrangement is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of DMW (at least pp. 1, 4). DMW discloses arranging photos according to Rock, alternative, etc. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the use of DMW's genre photo arrangement into Maniwa's storing files in a directory service as this would enhance Maniwa's system by allowing the image files to be stored in the directory by an easy to remember method such as a meeting or date, etc.

11. As per Claim 30.

further including the step of providing access to stored images for allowing image editing (image resolution conversion, rotation, etc) (at least col. 18, lines 17-58).

12. As per Claim 31.

wherein said editing step includes one or more of the steps of categorizing, sorting and titling (image file ID/name) (at least col. 14, lines 25-28).

13. As per Claim 33, Maniwa discloses a method of remotely uploading, storing, reviewing, and editing electronic photographic images on behalf of a customer, wherein Maniwa discloses:

fixing visual images on a persistent medium (image to be scanned) (at least col. 5, lines 48-53);

translating said visual images into electronic photographic images (scanning) (at least col. 5, lines 48-56);

transmitting said electronic photographic images to an order server (file/scan server) (at least col. 20, lines 16-22; col. 19, lines 48-50);

sequencing and captioning said electronic photographic images by said photographer (image file - 1...m) (at least Fig. 6);

storing said electronic photographic images on a memory at said order server for remote access (at least col. 19, lines 48-50);

displaying selected electronic photographic images from said memory to a remote customer (list user obtains) (at least col. 21, lines 52-62);

receiving an order from said remote customer enumerating a subset of said electronic photographic images (sending file request command for printout) (at least col. 20, lines 5-15);

producing a hardcopy rendition of said subset of electronic photographic images (printing) (at least col. 20, lines 51-54).



Maniwa does not explicitly disclose accessing the images over a public network using a client browser. However, the use and advantages for accessing items is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Franklin. Franklin discloses a client using a browser and ordering good online (at least col. 4, lines 15-61; abstract; Fig. 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Franklin's browser-based ordering into Maniwa's system because this would allow Maniwa's system to be used over a WAN such as the internet and Maniwa's clients to use browsers as Maniwa discloses an environment of various networks such as the internet or public networks (at least col. 22, lines 15-21) and Franklin clearly discloses using a browser over such networks.

Maniwa does not explicitly disclose said electronic photographic images obtained by a photographer at a customer event. However, the use and advantages for using such a photo arrangement is very well known to one skilled in the art at the time the invention was made as evidenced by the teachings of DMW (at least pp. 1, 4). DMW discloses arranging photos according to Rock, alternative, etc. Further, it is very well known that images are most commonly taken by a user with a camera, aka photographer, to capture a particular moment in time, such as an event, and that this limitation is irrelevant as to the novelty of the invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the use of DMW's genre photo arrangement into Maniwa's storing files in a directory service as this would enhance Maniwa's system by allowing the image files to

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be stored in the directory by an easy to remember method such as a meeting or date, etc.

14. As per Claim 10.

wherein said translating comprises scanning a visual image into a digital storage format (at least col. 18 line 66 - col. 19 line 4).

15. As per Claim 16.

wherein said displaying is followed by the step of electing a quantitative and qualitative assertion for at least one of said electronic photographic images (user selecting one or more displayed images) (at least col. 21, lines 52-62).

16. As per Claim 17.

wherein said electing further comprises storing at least one of said electronic photographic images in an electronic proofbook (directory service for user image list) (at least col. 21, lines 52-62).

17. As per Claim 19, has substantially similar content to claim 16 and is rejected as per claim 16.

18. As per Claim 20.

wherein said storing is preceded by the step of remotely altering/editing said electronic photographic images (image resolution conversion, rotation, etc) (at least col. 18, lines 17-58).

19. As per Claim 18.

Maniwa discloses a user directory service for storing and organizing image data files but does not explicitly disclose wherein said electronic proofbook is accessible only

by said customer. Official notice is taken that it was well known in the art at the time the invention was made to have authenticity measures so that only a specified user can access particular files. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement having users password protect files and/or a directory because this would prevent unauthorized users from viewing image data files that are confidential or private.

20. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maniwa in view of Franklin and DMW and further in view of Morag et al (hereinafter "Morag", 6,058,399).

Maniwa, Franklin, and DMW do not disclose using a digital camera to store said visual images therein. However, the use and advantages for using such an electronic photo capturing is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Morag (at least col. 6, lines 44-49). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate using a digital camera to create electronic photos to print as this was a commonly used method and alternative of creating digital photos along with scanning film.

### ***Response to Arguments***

21. The Applicant argues, substantially, that a) Maniwa fails to disclose sequencing and labeling images; b) DMW fails to disclose images are captured by a photographer

on behalf of a customer at an event; c) Maniwa fails to disclose a public network accessible by a browser;

22. Applicant's arguments with respect to a) and b) filed 21 November 2003 have been fully considered but they are not persuasive.

23. In response to a), Maniwa clearly discloses, as previously cited in Fig. 6 and similarly Fig. 9, the images as having been formatted and accordingly given an attribute of image file {1-m} and therefore sequenced and labeled accordingly for a directory service in order to retrieve the image file, as there would be no way to retrieve the image file if it isn't labeled in some manner.

24. In response to b), As Applicant notes, DMW is directed toward selling photos over the internet, wherein the photos are taken by a photographer from client events such as concerts, etc. It is well known that the source for any image or photograph eventually comes down to a photographer taking a picture of some event in time and DMW is simply relied on for doing such in an analogous art (ie. selling photos over the internet). Further, DMW is not relied on as having sequencing and labeling of such photographs.

25. Applicant's arguments, see pp. 8-9, filed 21 November 2003, with respect to c) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Franklin et al.

***Conclusion***

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Newly cited Franklin et al (identical system to immediate application without being images captured by a photographer on behalf of a customer at an event), Ogawa et al, Chalstrom et al, Fredlund et al, Dellert et al, Sheridan, Shiota et al, and Enomoto et al, in addition to previously cited Martin et al (payment server), Moghadam et al (networking photos), Brindle et al (photo description), Yien et al (networked image editing), Loeb (multimedia, photo delivery mechanisms), Woods (Kodak abstract for system claimed dated August '97), DaleLabs (digital film developing), Oldroyd Digital (digital film printing and editing), and WebPhotos (a very identical system to that claimed) are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory G Todd whose telephone number is (703)305-5343. The examiner can normally be reached on Monday - Friday 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703)308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

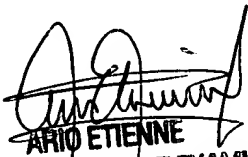
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Gregory Todd



Patent Examiner

1. Technology Center 2100



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